

INTERFERENCE DIGEST

Interference No. 105,612

Paper No.

Name: Hisashi Yamagishi et al.

Serial No.: 08/898,853

Patent No.

Title: Multi-piece solid golf ball

Filed: 07/25/97

Interference with Ohsumi et al.

DECISION ON MOTIONS

Administrative Patent Judge, _____ Dated, _____

FINAL DECISION

Board of Patent Appeals and Interferences, _____ Dated, _____

Court, _____ Dated, _____

REMARKS

This should be placed in each application or patent involved in interference in addition to the interference letters.



UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Fred E. McKelvey
Telephone: 571-272-4683
Facsimile: 571-273-0042

Applicants: YAMAGISHI
Application No.: 08/898,853
Filed: 07/25/97
For: Multi-piece solid golf ball

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,612.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

/FRED E. McKELVEY/
Senior Administrative Patent Judge

BoxInterferences@uspto.gov
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Paper 1
Entered: 29 January 2008

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference 105,612 McK
Technology Center 3700

SHUNJI OHSUMI, YASUHIRO FUKUI,
KENJI BABA, and HIROYUKI NAITO,

Patent 5,743,816,
Junior Party,

v.

HISASHI YAMAGISHI, HIROSHI HIGUCHI,
YASUSHI ICHIKAWA, and JUNJI HAYASHI,

Application 08/898,853
US Publication 2002/0034987 A1,
Senior Party,

DECLARATION

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Part A
Declaration of Interference

An interference is declared between the above-identified parties.
35 U.S.C. § 135(a); 37 CFR § 41.203(b).

Details of the application, patent, count and claims designated as
corresponding or as not corresponding to the count appear in Parts E and F
of this DECLARATION.

Part B
Judge Managing the Interference

Senior Administrative Patent Judge Fred E. McKelvey has been
designated to manage the interference. 37 CFR § 41.104(a).

Part C
Standing Order

A Trial Division STANDING ORDER (3 Jan. 2006) (Paper 2)
accompanies this DECLARATION.

The STANDING ORDER applies to this interference, including the
provisions related to Electronic Filing. See ¶ 105, pages 17-20.

1 **Part D**
2 **Initial Conference Call and Motions Lists**
3

4 Conference Call

5 A conference call to discuss the interference is set for:

6 **2 p.m. (1400 hours Eastern Time) on 19 March 2008.**

7 The Board will initiate the conference call.
8

9 Motions Lists

10 On or before:

11 **Noon (1200 hours Eastern time) on 14 March 2008,**

12 each party shall file, and on or before:

13 **5:00 p.m. (1700 hours Eastern time) on 14 March 2008,**

14 each party shall serve a notice stating the relief the party requests, *i.e.*, a
15 motions list including motions the party seeks authorization to file. 37 CFR
16 § 41.120(a); STANDING ORDER ¶ 204 (Paper 2, page 58).

17 The default procedure for filing and serving motions lists is that
18 motions lists are to be *filed* before being *served*.

19 By filing before service, one party will not have access to an
20 opponent's motions list prior to the filing of the party's motions list.

21 Nevertheless, the parties may mutually agree to discuss and serve
22 motions lists at any time prior to the date and time motions lists are due.

23 The following shall be included in motions lists.

24 (1) Proposed motion for benefit (*i.e.*, to be accorded an
25 earlier constructive reduction to practice) must identify the application(s) for
26 which benefit will be sought.

1 (2) Proposed motion to attack benefit must identify the
2 application(s) to be attacked.

3 (3) Proposed motion seeking judgment against an opponent
4 based on alleged unpatentability must identify the statutory basis for the
5 alleged unpatentability and:

6 (a) if based on prior art, identify the prior art;

7 (b) if based on the first paragraph of 35 U.S.C. § 112,
8 (i) identify whether written description, enablement or best mode will be the
9 basis for the motion, and (ii) briefly identify the basis for any alleged
10 unpatentability;¹

11 (c) if based on an alleged failure to comply with
12 35 U.S.C. § 135(b), briefly identify the reason;

13 (d) if based on the second paragraph of 35 U.S.C.
14 § 112, identify the limitation which is believed to be indefinite.

15 (4) Proposed motion based on no interference-in-fact shall
16 briefly identify the reason no interference-in-fact is believed to exist.

17 (5) Proposed motion to designate additional claims as
18 corresponding to a count or as not corresponding to a count shall identify the
19 claims involved.

¹ A merits panel of the Board has determined that involved Yamagishi claims 13-19 comply with the written description requirement of 35 U.S.C. § 112, first paragraph. *Ex parte Yamagishi*, Appeal 2004-1203, Paper 62 (Bd. Pat. App. & Int. Feb. 24, 2005). While entitled to respect, an *ex parte* decision is not binding in a subsequent *inter partes* case. See (1) *Keystone Bridge Co. v. Phoenix Iron Co.*, 5 Otto (95 U.S.) 274, 279 (1877); (2) *Sze v. Bloch*, 458 F.2d 137 (CCPA 1972); (3) *Switzer v. Sockman*, 333 F.2d 935 (CCPA 1964), *cert. denied*, 380 U.S. 906 (1965); (4) *Turchan v. Bailey Meter Co.*, 167 F. Supp. 58, 63-64, (D. Del. 1958); (5) *Glaxo Wellcome Inc. v. Cabilly*, 56 USPQ2d 1983 (Bd. Pat. App. & Int. 2000). See also *In re Trans Texas Holdings Corp.*, 498 F.3d 1290 (Fed. Cir. 2007).

1 (6) Proposed motion to add or substitute a new count shall
2 explain why the added or substitute count is necessary.

3 A motions list shall not contain any "reservation clause" whereby a
4 party purports to reserve a right to file additional motions. Additional
5 motions are those authorized by the Board consistent with the rules.

6 A sample schedule for taking action during the motions phase of the
7 interference appears as Form 2 (page 69) of the STANDING ORDER.

8 Counsel are encouraged to discuss the schedule prior to the
9 conference and agree on times for taking action generally consistent with the
10 sample schedule.

11 A typical motions phase last about eight (8) months.

12 The parties should be prepared at the conference to justify any request
13 for shorter or longer time periods.

14

1 **Part E**

2
3 **Identification of the Parties**
4 **Assignment of Exhibit Numbers**
5 **Initiating Settlement Discussions**
6

7 **Junior Party**

8
9 Inventors: Shunji Ohsumi, Japan
10 Yasuhiro Fukui, Japan
11 Kenji Baba, Japan
12 Hiroyuki Naito, Japan
13
14 Patent: U.S. Patent 5,743,816²
15 issued 28 April 1998
16 based on application 08/835,023,
17 filed 27 March 1997
18
19 Title: Solid Golf Ball
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21 Real party in interest: Kasco Corporation
22

² PALM records of the U.S. Patent and Trademark Office show that maintenance fees were paid on (1) 31 August 2001 (\$850) and (2) 07 October 2005 (\$2,300). Accordingly, the Ohsumi patent has not expired.

Senior Party

Inventors:

Hisashi Yamagishi, Japan
Hiroshi Higuchi, Japan
Yasushi Ichikawa, Japan
Junji Hayashi, Japan

Application:

Application 08/898,853,
filed 25 July 1997,
US Publication 2002/0034987 A1
published 21 March 2002

Title:

Multi-piece solid golf ball

Real party in interest:

Bridgestone Sports, Co., Ltd.

1 Assignment of Exhibit Numbers

2 Yamagishi: Exhibit Numbers 1001 through 1999.

3 Ohsumi: Exhibit Numbers 2001-2999.

4 Board: Exhibit Numbers 3001-3999.

5

6 Initiating Settlement Discussions

7 STANDING ORDER ¶ 126.1 (Paper 2, pages 40-41)

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9 The senior party is responsible for initiating settlement discussions

10 required by the STANDING ORDER.

1 **Part F**
2 **Count and Claims of the Parties**

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4 **Count 1**

5 A solid golf ball according to claim 1 of Ohsumi patent,
6 5,743,816 or a solid golf ball according to claim 13 of
7 Yamagishi application 08/898,853.

8
9 Ohsumi claim 1

10
11 1. A solid golf ball comprising a solid core having a three-layered
12 structure composed of an inner layer, an intermediate layer formed outside
13 said inner layer, and an outer layer formed outside said intermediate layer,
14 and a cover for coating said solid core, wherein:

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16 said inner layer is designed to have a Shore D hardness which is lower
17 than that of said intermediate layer;

18
19 said intermediate layer is designed to have a Shore D hardness of 45
20 to 65; and

21
22 said outer layer is designed to have a Shore D hardness which is lower
23 than that of said intermediate layer.
24

25 Yamagishi claim 13

26 13. A solid golf ball comprising a solid core having a three-layered
27 structure composed of an inner layer, an intermediate layer formed outside
28 said inner layer, and an outer layer formed outside said intermediate layer,
29 and a cover for coating said solid core, wherein:

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31 said inner layer is designed to have a Shore D hardness which is lower
32 than that of said intermediate layer;

33
34 said intermediate layer is designed to have a Shore D hardness of 45
35 to 65; and
36

1 said outer layer is designed to have a Shore D hardness which is lower
2 than that of said intermediate layer.
3

4 The claims of the parties are:
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6 Ohsumi: 1-7

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8 Yamagishi: 13-19³
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10 The claims that correspond to Count 1 are:
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12 Ohsumi: 1-7

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14 Yamagishi: 13-19
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16 The claims that do not correspond to Count 1 are:
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18 Ohsumi: None

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20 Yamagishi: None
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³ In presenting a clean copy of its claims, Yamagishi shall clarify which claims are pending in the involved Yamagishi application. In an *ex parte* opinion, an *ex parte* merits panel of the Board indicates (1) that an appeal was taken as to claims 13-19 (page 1), (2) that claims 14-15 and 18 "have since been cancelled" (page 3, n.2), and (3) reverses a rejection of claims 13-19 (page 5). *Ex parte Yamagishi*, Appeal 2004-1203 (Bd. Pat. App. & Int. 24 Feb 2005). In transmitting a recommendation to the Board for an interference the Examiner indicates that Yamagishi claims 13-19 should be involved in the interference.

1 The parties are accorded an earlier constructive reduction to practice
2 (i.e., benefit for the purpose of priority) of the following applications:⁴

3 Ohsumi: None

4 Yamagishi: Application 08/661,778,
5 filed 13 June 1996,
6 now U.S. Patent 5,688,595,
7 issued 18 November 1997.
8

⁴ Ohsumi claims priority based on Japanese patent application 8-79203, filed 01 April 1996. Yamagishi claims priority based on Japanese patent application 7-171520, filed 14 June 1995. Constructive reductions to practice based on the Japanese applications are *not* accorded at this time. On or before **27 February 2008**, both parties are authorized to file (in the form of an exhibit) and serve (1) a copy of its Japanese patent application and (2) a verified translation of its Japanese application. The Board will undertake a *sua sponte* review of any timely filed translation and make an *ex parte* determination whether an earlier constructive reduction to practice should be accorded to a party. The decision not to accord an earlier constructive reduction to practice at this time and any *ex parte* decision to accord an earlier constructive reduction to practice upon review of any timely filed translation, is without prejudice (1) to a party listing a motion for benefit in its motions list or (2) to the parties agreeing that earlier constructive reductions to practice should be accorded to one or both parties. A party may advise the Board if it believes that its opponent is entitled to an earlier constructive reduction to practice based on its Japanese patent application. Upon review of the translations and any agreement submitted by the parties, the Board will *sua sponte* redeclared the interference.

Part G
Heading to be Used on Papers

The following heading shall be used on all papers filed in this
interference [STANDING ORDER ¶ 106.11 (Paper 2, page 20)].

Filed by: [name of party] Paper _____
[Name of attorney] Date filed: [enter date emailed to Board]
[Email address of attorney]
[Telephone number of attorney]

Patent Interference 105,612 McK
Technology Center 3700

SHUNJI OHSUMI, YASUHIRO FUKUI,
KENJI BABA, and HIROYUKI NAITO,

Patent 5,743,816,
Junior Party,

v.

HISASHI YAMAGISHI, HIROSHI HIGUCHI,
YASUSHI ICHIKAWA, and JUNJI HAYASHI,

Application 08/898,853
US Publication 2002/0034987 A1,
Senior Party,

Title of Paper, *e.g.*, YAMAGISHI SUBSTANTIVE MOTION 1

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Part H
Order Form for Requesting File Copies

When requesting file copies, a party shall use STANDING ORDER Form 4 (page 71).

Use of form 4 will expedite processing of any request.

a party should attach to any request for file copies a photocopy of Part E of this DECLARATION with a hand-drawn circle around the patent and application files for which a copy of a file wrapper is requested.

The parties are advised that a single order for file copies may be filled by the Office of Public Records at more than one time. STANDING ORDER ¶ 109.2 (Paper 2, pages 25-27).

Part I
Required Paragraph of Affidavits and Declarations

The Board has experienced cases in which a witness has belatedly advanced reasons why the witness would be unable to appear for cross examination at a reasonable time and place in the United States.

Consequently, to prevent surprise and hardship to the party relying on the testimony of a witness, the following paragraph must be included on the signature page of all affidavits (including declarations) filed in this case.

STANDING ORDER ¶ 157.2 (Paper 2, pages 52-53).

In signing affidavit (declaration), I understand that the affidavit (declaration) will be filed as evidence in a contested case before the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office. I also acknowledge that I may be subject to cross examination in the case and that cross

1 examination will take place within the United States. If cross
2 examination is required of me, I will appear for cross
3 examination within the United States during the time allotted
4 for cross examination.

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14 Entered at:

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16 Kailua, HI

17 29 January 2008

/s/ Fred E. McKelvey)
FRED E. McKELVEY)
Senior Administrative Patent Judge)

1 cc (via Federal Express):
2
3 Attorney for Ohsumi
4 (real party in interest:
5 Kasco Corporation):
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15 Attorney for Yamagishi
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